

Remarks

Claims 1-11, and 13 have been amended to more precisely claim the present invention. To expedite issuance of this patent application claim 1 was amended to include some of the claim language previously found in dependent claim 7 and as such does not contain new matter. Applicant's amendment to claim 1 is without prejudice. Applicant reserves the right to reintroduce the subject matter of claim 1 as originally filed or of similar scope in a continuation, divisional application or other subsequent related application to be filed at the U.S. Patent and Trademark Office. In fact, a continuation application of this application has been filed with the subject matter of claim 1 on the same day that this response is being filed. Claim 5 was amended to include deriving the estimated costs from the data stored in the database. Support for this amendment to claim 5 can be found in the language of claim 1 as originally filed as well as paragraph [0008] of the specification and as such does not contain new matter. Claims 12 and 14-19 have been canceled; however, the Applicant reserves the right to pursue those claims or ones of similar scope in subsequent continuation or divisional patent application.

New claims 20-49 have been added. Support for new claim 20 can be found in the language of claim 1 as originally filed. Support for new claims 21-23 can be found in the language of claim 3 as originally filed. Support for new claims 24-26 can be found in the language of claim 9 as originally filed. Support for new claim 27 can be found in the language of claim 1 as originally filed. Support for new claim 28 can be found in paragraphs [0030], [0044] and [0060] of the specification. Support for new claim 29 can be found in paragraphs [0030] through [0033] of the specification. Claims 30-49 are new apparatus claims containing language similar to method claims 1-10 and 20-29. Therefore, none of the new claims contain new matter.

Claims 1-11, 13, and 20-49 remain pending in the application.

Information Disclosure Statement

A Supplemental Information Disclosure Statement that cites references cited in related applications is being submitted along with this Amendment.

Amendments to Specification

Amendments have been made to paragraph [0070] of the specification that substantially duplicate the language found in claims 6 and 7 of the application as originally filed. As such this amendment does not constitute new matter being added to the specification.

Claim Objections

Claims 11-14 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. In particular, the Examiner stated that claims 11-14 do not pass the "Infringement Test" for dependent claims. As summarized in MPEP § 608.01(n) and referring to the court opinion Ex parte Porter, 25 USPQ2d 1144, "the test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. ... A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim." The Examiner has not specifically identified how claims 11-14 fail to meet this "Infringement Test". Nonetheless, claims 11 and 13 have been amended to clarify their dependent relationship with claim 1. These type of claims has been determined to cover patentable subject matter by the courts. See for example the decision in the case of In re Beauregard, 35 USPQ2d 1383 (1995). Claims 12 and 14 have been canceled. The Applicant respectfully requests that the objection to claims 11 and 13 under 37 CFR 1.75(c) be withdrawn.

35 U.S.C. §101

Claims 1-10 and 13-14 were rejected under 35 USC 101 as being directed to non-statutory subject matter. In particular, the Examiner stated that the claimed inventions does not fall within the technological art. The Applicant disagrees with the Examiner's assertions concerning non-statutory subject matter of the claims. Claims involving computerized implementations of business methods and methods performed by computer systems have long been held to be statutory subject matter. See for example, State Street v. Signature Financial Group, 47 USPQ 2d 1596 (Fed. Cir. 1998). The claims have been amended to emphasize the use of a sales computer system in conjunction with performing the method of generating an insurance proposal. In view of the foregoing, the Applicant requests reconsideration and withdrawal of the rejection of claims 1-10 and 13-14 under 35 USC 101 as being directed to non-statutory subject matter.

35 U.S.C. §102

The Examiner rejected claims 1-5, 11 and 13 under 35 U.S.C. 102(b) as being anticipated by Lockwood 4,567,359. Lockwood '359 generally describes a self-service system for dispensing information, goods and services such as insurance quotations and policy binders agreements. In particular, Lockwood '359 does not teach presenting a description of insurance plan options that includes an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data as specified in independent claim 1. Further, Lockwood '359 does not teach generating a customized proposal in the computer system based upon a selection made from the presented insurance plan options that includes a description of the insurance plan, customer data, and estimated costs for the insurance plan. Claims 2-5, 11, and 13 as well as new claims 20-29 depend from claim 1 and therefore are allowable over Lockwood '359 for the same reasons that claim 1 is allowable. Therefore, under 35 U.S.C. 102(b), Lockwood '359 fails to teach the present invention as claimed in claims 1-5, 11, and 13 as well as new claims 20-49, and a notice of allowance is respectfully requested.

35 U.S.C. §103

Claims 6 through 10, 12, and 14 were rejected under 35 USC §103(a) as being unpatentable over Lockwood 4,567,359 in view of Gamble, et al., 6,163,770. Applicant respectfully suggests that the Examiner has failed to establish a *prima facie* case of obviousness for two reasons. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine the reference teachings. Secondly, the cited references, when combined, fail to teach or suggest all the claim limitations. The necessary teaching or suggestion to make the claim combination and the reasonable expectation of success is not both found in the cited references. In view of the amendments to independent claim1 and the associated dependent claims claim 6-10 and the cancellation of claims 12, and 14 the Applicant respectfully suggests that Lockwood '359 and Gamble '770 when considered individually or together in combination, fail to suggest or teach all of the elements of the presently pending amended claims 6-10. For example, as noted previously in reference to Lockwood '359 alone, amended independent

claim 1 describes presenting a description of insurance plan options that includes an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data which is not taught by either Lockwood '359 or Gamble '770. Claims 6-10 depend from claim 1 and therefore are allowable over Lockwood '359 and Gamble '770 for the same reasons that claim 1 is allowable.

Claims 15-16 were rejected under 35 USC §103(a) as being unpatentable over Lockwood '359 in view of Gamble '770 and further in view of Mori, et al., 6,070,148. In addition, claims 17-19 were rejected under 35 USC §103(a) as being unpatentable over Gamble '770 in view of Mori '148 and further in view of Schotz 4,837,693. These claims 15-19 have been canceled from this application and therefore this rejection is now moot.

Applicant has reviewed the other references cited the by Examiner and determined that they do not teach or suggest the present invention.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 1-11, 13, and 20-49 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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